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JEAN-MARC ZIMMERMAN
226 ST PAUL STREET
WESTFIELD, NJ 07090

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In re Application of
Lin-Hendel
Application No. 09/631,238
Filed: August 2, 2000
Attorney Docket No. Lin-Hendel 7

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OFFICE OF PETITIONS

ON PETITION

This decision concerns the February 17, 2004 "Petition under 37 CFR 1.137(a) to Revive Abandoned Application."

The petition is **DISMISSED**.

On September 5, 2002, a non-final Office action was mailed, setting forth a 3-month shortened statutory reply period.

On January 13, 2003 (Certificate of Mailing date January 3, 2003), an amendment was filed, but was not accompanied by the requisite extension-of-time fee. In addition, the application was filed without a constructive petition for an extension of time as provided in 37 CFR 1.136(a)(3). Accordingly, the application became abandoned on December 6, 2002.

The instant petition requests revival of the application under the "unavoidable" delay standard of 37 CFR 1.137(a).

A grantable petition under 37 CFR 1.137(a), in the instant case, must include:

- (1) the required reply;¹
- (2) the \$55 petition fee (small entity);²
- (3) a **showing** to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date until the filing of a grantable §1.137(a)

¹ The "required reply" to a non-final Office action may be: an argument or an amendment fully responsive to the Office action in question; the filing of a continuing application under 37 CFR 1.53(b); or the filing of a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114 if the utility application was filed on or after 6/8/95. MPEP 711.03(c)(III)(A) (Rev. 1, Feb. 2003). In the instant case, the 1/13/03 amendment satisfies this requirement.

² Enclosed with petition.

petition was unavoidable.³

As discussed below, the petition lacks item (3).

The USPTO record shows that on March 14, 2003, after the application had become abandoned, a request for a 1-month extension of time and a \$55 payment were submitted. According to the instant petition, the March 14, 2003 submission was triggered by a telephone call from a USPTO employee. The Office notes that an alleged oral advise by a USPTO employee cannot be accepted as evidence in this petition.⁴ Moreover, the offer of a request for an extension of time on March 14, 2003 indicates counsel's unfamiliarity with the fact that the 6-month statutory period had already expired by then. Unfortunately, a delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice . . . does not constitute "unavoidable" delay within the meaning 37 CFR 1.137(a).⁵

In view of the above, the petition is dismissed.

Options

- (I) A renewed §1.137(a) petition may be filed to revive the application (no fee). To be grantable, such a renewed petition must:

-be filed within **TWO MONTHS** of the mailing date of this decision;⁶

-include **sufficient showing** that the **entire** delay in filing the required reply was "unavoidable";

and should be addressed as follows:

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- (II) Applicant may revive the application based on unintentional abandonment under 37

³ An intentional delay in seeking the revival of an abandoned application precludes a finding of unavoidable delay under 37 CFR 1.137(a). See MPEP section 711.03(c)(III)(D) (Rev. 1, Feb. 2003); 35 U.S.C. 133; Douglas v. Manbeck, 21 U.S.P.Q.2d 1697; 1991 U.S. Dist. LEXIS 16404, 16412-13 (E.D. Pa. 1991); In re Takao, 1990 Dec. Comm'r Pat. 6, 10 (Comm'r Pat. 1990), 7 U.S.P.Q.2d 1155, citing Ex Parte Naef, 1905 Dec. Comm'r Pat. 121 (Comm'r Pat. 1905).

⁴ See 37 CFR 1.2.

⁵ MPEP 711.03(c)(III)(C)(2) (Rev.1, Feb. 2003).

⁶ 37 CFR 1.137(e)(1); extensions of time under 37 CFR 1.136(a) are available.

CFR 1.137(b).⁷ For the instant application, such a petition requires a \$665 petition fee (small entity),⁸ and a **statement** that the **entire** delay in submitting the required reply to the September 5, 2002 Office Action from the due date until the filing of a grantable §1.137(b) petition was unintentional.⁹

While a §1.137(b) petition is not subject to the 2-month limitation, intentionally delaying the filing of such a petition defeats the purpose of this provision, and will result in dismissal of the petition.

A §1.137(b) petition, if filed, should also be addressed as instructed above.

Finally, the petition encloses a \$210 check intended for a 2-month extension of time. However, an extension of time under 37 CFR 1.136 may only be obtained prior to expiration of the maximum extendable reply period.¹⁰ The request for extension of time submitted with the instant petition, like the March 14, 2003 payment of \$55 for a 1-month extension of time, is not applicable, in that, it is filed subsequent to the maximum extendable reply period, i.e., subsequent to March 5, 2003. The 2 fees, totaling \$265, have been refunded.

Telephone inquiries should be directed to the undersigned at (703) 308-0763.



RC Tang
Petitions Attorney
Office of Petitions

⁷ Such petitions are evaluated under the less stringent "unintentional delay" standard. MPEP section 711.03(c)(III)(C) (Rev. 1, Feb. 2003). The dismissal or denial of a §1.137(a) petition does not preclude an applicant from obtaining relief under §1.137(b) unless the decision dismissing or denying the §1.137(a) petition states otherwise. MPEP section 711.03(c)(III)(C)(2) (Rev. 1, Feb. 2003).

⁸ A fee is required because a §1.137(b) petition is not a renewed §1.137(a) petition.

⁹ See 37 CFR 1.137(b)(3).

¹⁰ See In re Application of S., 8 U.S.P.Q.2d 1630, 1631 (Comm'r Pats. 1988).